

## **REMARKS**

Claims 1-13 are currently pending in the application. Claims 1, 4-8, and 11-13 have been amended; claim 9 has been canceled and claim 14 has been added. Applicant respectfully asserts that no new matter has been added and requests reconsideration of the claims currently pending in the application.

The Examiner's request for another copy of the Declaration and Power of Attorney is recognized and a copy is provided herewith.

The Examiner objects to the specification because of an informality in the Abstract. "Significant Figure 5" is removed and the replacement Abstract page submitted herewith.

The Examiner also objects to the layout and line spacing for the specification. The layout is herewith corrected and a replacement specification that is double-spaced is submitted. The proper section headings have been added to the replacement specification as indicated on page 2 of this amendment.

Applicant respectfully requests the Examiner to withdraw the objections to the specification.

In paragraph 6 on page 3 of the Office Action, claims 1-13 are rejected under 35 U.S.C. 112, first paragraph as not providing reasonable enablement for a method of aspirating a gas into a capillary by applying a reduced pressure (that is less than the critical of the gas) to the gas and further preventing the aspiration

of liquid due to the equilibrium reached between the reduced pressure and the aspirated gas. Applicants respectfully traverse the rejections.

Applicant respectfully asserts that the present description does enable one skilled in the art to make and use the invention commensurate in scope with the claims, particularly when taking a gas as a first fluid and a liquid as a second fluid.

Even if the aspiration of a liquid as a first fluid is explained in the present description, there are also notes in the description that explain the differences when aspirating a gas as a first fluid into the capillary device. For example, on page 3, lines 6 to 11, it is explained that in this case, the reduced pressure is set in such a way that it does not exceed the surface tension of the second fluid which is a liquid. Therefore, the gas will be aspirated into the capillary device, while the liquid is prevented to be taken up into the capillary device by the surface tension of the fluid at the end of the capillary device. Because the reduced pressure depends on the surface tension of the liquid and not on a surface tension of the gas, common pumps are able to apply such reduced pressure.

The Examiner further notes that a gas will occupy the internal space absent of liquid and that the gas will move out of the capillary device when aspirating the liquid. However, in this case, it is not necessarily true that the gas will occupy the internal space automatically. For example, a gas that is more dense than air will remain in a vessel until it is aspirated by some small pressure.

According to the above discussion and the specification, this pressure must not be higher than a reduced pressure which depends on the surface tension of the liquid.

Therefore, the specification does enable one skilled in the art to make and use the invention commensurate in scope with the claims.

Applicant respectfully requests the Examiner withdraw the rejection of claims 1-13 are rejected under 35 U.S.C. 112, first paragraph as not providing reasonable enablement for a method of aspirating a gas into a capillary by applying a reduced pressure (that is less than the critical of the gas) to the gas and further preventing the aspiration of liquid due to the equilibrium reached between the reduced pressure and the aspirated gas.

In paragraph 8 on page 6 of the Office Action, the Examiner rejects claims 1, 6 and 13 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant traverses the rejections.

Applicant submits herewith amended claims 1, 6 and 13 to assist in overcoming the rejection and now believes they are in condition for allowance.

Applicant respectfully requests the Examiner withdraw the rejection of claims 1, 6 and 13 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In paragraph 10 on page 7 of the Office Action, the Examiner rejects claims 1, 4, 6, 9, 11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Kenny (U.S. 4,461,328) in view of Kawanabe et al. (Applicant assumes this to be an error and that the correct reference is actually Castaneda (U.S. 5,452,619). Applicant traverses the rejections and submits arguments focusing on the Kenny/Castaneda combination.

According to the Examiner, it would have been obvious to modify the pipette tubes of Kenny to have dimensions as taught by the self filling device of Castaneda to allow for the application of a reduced pressure provided by the vacuum to reduce the required work of the vacuum and increase the efficiency of the device.

But, since both references only provide for the capturing of a predetermined volume of a liquid, even when combined, it is not possible for them to capture the liquid fully.

Contrary to this, the subject matter of the present application as claimed in independent claims 1 and 6 is capable of taking up a first fluid fully, while preventing the taking up of a second fluid, even when the exact volume of the first fluid is not known. This is because the further taking up of the second fluid will not be possible, since the reduced pressure is not capable to overcome the surface tension of the liquid at the end of the pipette device.

Thus, neither Kenny, nor Castaneda, nor the combination thereof, claims or discloses all the claim limitations. Further, neither reference, nor the combination thereof, provides a hint or suggestion regarding the taking up of a first fluid fully,

while preventing the taking up of a second fluid, even when the exact volume of the first fluid is not known.

Three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142. Kenny in view of Castaneda fail to render independent claims 1 and 6 obvious because the combination of references fails to teach or suggest all the claim limitations contained in claims 1 and 6.

Dependent claim 4, which depends from independent claim 1, and dependent claims 9, 11 and 13, which depend from independent claim 6, were rejected under 35 U.S.C. §103(a) as being unpatentable over Kenny in view of Castaneda. While Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with amended independent claims 1 and 6. These dependent claims include all of the limitations of the now amended base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 4, 9, 11, and 13 are in condition for allowance.

Applicant respectfully requests withdrawal of the rejection of claims 1, 4, 6, 9, 11 and 13 under 35 U.S.C. § 103(a) as being anticipated by Kenny in view of Castaneda and favorable reconsideration of claims 1, 4, 6, 9, 11 and 13.

In Paragraph 11 on page 9 of the Office Action, the Examiner rejects claims 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over Kenny in view of Castaneda as applied to claims 1, 4, 6, 9 and 13 above, and further in view of Tajima (U.S. 5,895,631). Applicant respectfully traverses the rejection.

According to the Examiner, claims 7 and 8 are not patentable in view of the modified teachings of Kenny and Castaneda and in further view of the chip analysis pipetting system of Tajima.

As discussed above, since the apparatus (pipette device) for taking up a first medium is new and not obvious, the combination of the apparatus for taking up a first medium with an analysis chip for analyzing the first medium will also be new and not obvious; Tajima's teaching does not rectify the failings of the combination of Kenny and Castaneda.


As a result, claims 7 and 8 are not unpatentable under 35 U.S.C. 103(a) over Kenny in view of Castaneda as applied to claims 1, 4, 6, 9 and 13 above, and further in view of Tajima. Applicant respectfully requests the Examiner withdraw the rejection and further requests favorable consideration of claims 7 and 8.

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicant respectfully requests , favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Jeffrey R. Stone at (952) 253-4130.

Respectfully submitted,  
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